



Attorney Case No. 902OE002.C1

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Gilliland, et al.

Title: Automatic Power Control and Laser Slope  
Efficiency Normalizing Circuit

Serial No.: 10/015,103

Parent Filed: February, 4, 2000

Continuation Filed: December 11, 2001

Group Art Unit: 2874

Examiner:

**PETITION TO TREAT DECLARATION AND ASSIGNMENT AS BEING  
SIGNED BY ALL INVENTORS PURSUANT TO 37. C.F.R. §1.47**

Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Based on the facts stated herein, Applicants and Assignee hereby petition the Commissioner to treat the filed Declarations and Assignments as being signed by all inventors. There are five inventors on this application, Patrick B. Gilliland, Luis Torres, Evgueniy Anguelov, Mike A. Ward, and David C. Schie. All the inventors have signed the Declaration and Assignment, except for David Schie. Patrick B. Gilliland, Luis Torres, and Evgueniy Anguelov were employees of Methode Electronics. Mike A. Ward and David C. Schie were employees of Linear Dimensions.

Stratos Lightwave was a fully owned subsidiary of Methode Electronics, the original assignee of this application. In June 2000, Stratos Lightwave spun off from Methode Electronics to become an independent company. At the time of the spin off, Methode Electronics assigned this application to Stratos Lightwave.

The present application was filed on February 4, 2000. Prior to filing this application, Methode Electronics and Linear Dimensions entered into an Agreement on March 5, 1998, to develop a custom integrated circuit. (Enclosed with this Petition). Section 2.8 of the Agreement clearly states that intellectual patent rights to the integrated

circuit (IC) shall be the property of Methode Electronics, even though some of the inventors may be from Linear Dimensions.

Prior to filing the application, Methode and Linear Dimensions disagreed on the quality of the IC produced by Linear Dimensions. As a result of that dispute, Mike Ward and David Schie, employees of Linear Dimensions, initially refused to sign the application. Mike Ward, the Vice President of Linear Dimensions, later agreed to sign the Declaration and Assignment. David Schie, however, continued to refuse to sign the Declaration and Assignment. Furthermore, Methode Electronics was informed by Linear Dimensions that David Schie was no longer employed by Linear Dimensions. Methode Electronics filed the application believing that Mr. Schie would later sign the Assignment and Declaration, despite leaving Linear Dimensions.

Stratos now owns the rights to the present application, which has been allowed. Stratos has been informed that an ongoing dispute exists between Linear Dimensions and Mr. Schie. Unfortunately, as of the current date, Mr. Schie is unwilling to sign the Declaration and Assignment unless Stratos agrees to assist Mr. Schie in his dispute with Linear Dimensions. Stratos is unwilling to take sides or a position in the dispute between Mr. Schie and Linear Dimensions.

Stratos Lightwave has a significant financial investment in the development of the intellectual property covered by claims of the subject application, which has been allowed. The granting of this Petition is necessary to prevent irreparable harm and a complete loss of the investment made by Stratos Lightwave in this project. Accordingly, the Commissioner is respectfully requested to grant this petition to avoid the irreparable harm to the assignee of this patent application, Stratos Lightwave. Authorization to charge Stratos' deposit account the appropriate fee and the last known address of Mr. Schie are enclosed with this application.

Respectfully Submitted,

Date June 21, 2002

Steven M. Evans  
Steven M. Evans, Reg. No. 35,503  
Senior Patent Counsel  
Stratos Lightwave, Inc.  
7444 West Wilson Ave.  
Chicago, IL 60706  
708-867-9600



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## PARTNERSHIP PROGRAM CUSTOM A<sup>2</sup>SIC AGREEMENT

This agreement made on the 5<sup>th</sup> day of March, 1998 by and between Linear dimensions ("Linear") and Methode Electronics, Inc. ("Methode").

**WHEREAS**, Linear Dimensions designs, manufactures and sells custom integrated circuits and is a corporation incorporated and in good standing under the laws of the State of Illinois, having requisite authority to enter into an Agreement of this type;

**WHEREAS**, Methode Electronics, Inc. is an electronics component manufacturer and is a corporation incorporated and in good standing under the laws of the State of Illinois, having requisite authority to enter into an Agreement of this type;

**NOW, THEREFORE**, the parties agree as follows:

### 1.0 Design, Prototype, Manufacture, and Testing Agreement

- 1.1 Linear Dimensions hereby agrees to design, to the best of its abilities and in conjunction with Methode, an analog application specific integrated circuit (A<sup>2</sup>SIC) to fulfill the specifications in Schedule 'A', producing an IC for Methode's optical transceiver product which shall hereinafter be called "IC".
- 1.2 The spirit of this Agreement is agreed to be such that both Methode and Linear will co-operate, work together, make reasonable concessions, and use their best efforts at all times to produce an IC which will make a functionally viable IC for Methode.
- 1.3 Specifications for IC are provided as Schedule 'A'. Should it be necessary to adjust the specifications due to design or process constraints, and in the opinion of Methode and Linear would still make a workable product, then it shall be acceptable to substitute those newly derived parameters in place of those which were unattainable.
- 1.4 Linear will produce prototypes for examination by Linear and Methode, however, Methode will accept reasonable non-conformance of these prototypes with specifications provided that Linear can demonstrate a method of remedy is included in the final design or it is decided that the new specifications are acceptable. In other words, Methode will not force re-spins for unsubstantive issues or issues which it can be reasonably assured have been corrected in the layout of the final design.
- 1.5 Linear will manufacture at least the first 100,000 ICs for Methode at \$1.80 per IC or less. These pieces will be approximately 12 weeks ARO, FOB Linear.

### 2.6 Property Rights

- 2.7 Linear hereby agrees that the IC shall be manufactured and sold exclusively to Methode and may not be made available to any other customer of Linear. Linear will not make optoelectronic transceiver controllers for any other company, unless Methode fails to meet its obligations under 4.0, Minimum Purchase Agreement.
- 2.8 Intellectual patent rights to the IC shall be the property of Methode, however, all related patents, trademarks or other intellectual registries shall bear the name of Linear & relevant personnel as co-inventors where such personnel are inventors, as defined by the patent statute. Linear agrees that such registries shall be assigned to Methode, and that its personnel will cooperate in helping to prepare and execute any papers necessary to prosecute the patents.



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- 2.9 Methode shall have the right to patent the IC only and shall in no way bar Linear's right to carry out business with other customers for products other than the IC and pursuant to paragraph 2.1 above. Methode shall in no way invalidate or disallow the use of proprietary Linear cells. Methode also shall not patent techniques derived independently by Linear Dimensions in the name of Methode without the consent of Linear.

### 3.10 Payment

- 3.11 In return for the development mentioned above, Methode hereby agrees to pay the following:

\$20k	Upon acceptance of this Agreement.
\$5k	Upon Delivery of Functional (though not necessarily perfect) Prototypes by Linear
\$20k	Upon Initiation of Mask Build by Linear
\$20k	Upon Initiation of Engineering Wafer Run by Linear
\$10k	After Receipt of Engineering Samples (approx. 100 pcs) by Methode

A target schedule is included as Schedule 'B'.

### 4.0 Minimum Purchase Agreement

All provisions in 4.0 below are contingent upon satisfactory completion of 3.0:

4.1 Methode hereby agrees that it will purchase a minimum of 100,000 pieces of IC within one year of Design Approval of Functioning Engineering Samples, according to Methode's standard terms and conditions included on the attached Methode P.O. Where the conditions on the enclosed Methode P.O. conflict with this agreement, for example where Methode may cancel without liability, then this agreement shall rule. Methode does not have the right to purchase less than 100,000 pieces over the course of a year despite Methode's standard P.O. terms & conditions.

4.2 Further to Section 2.0 in which Linear agrees that it will not make controllers for optoelectronic transceiver products made by others, Methode in return agrees that a minimum of 50% of its annual purchases of optoelectronic transceiver control IC's will be made from Linear provided Linear's prices are within 20% of 3 legitimate competitive bids obtained by Methode and Linear. Linear will reserve the right to verify and ensure that the same service is being provided. Pursuant to this, Methode will provide a mechanism for verifying its yearly volume.

### 5.0 Termination

5.1 In no event, shall Linear be liable for delay in the rendering of services contained herein. Schedule 'B' includes a proposed schedule, however, this schedule is a target. Both companies shall use their best efforts to meet these targets. Should the design of Methode's IC not be complete in the opinion of both parties, after the first year, then either party may terminate this agreement. Methode may terminate the agreement if Linear is in breach of any of the terms of the agreement and has failed to take steps to cure the breach within 30 days notice by Methode.

5.2 Linear reserves the right to terminate this Agreement at any time only so long as it returns all monies paid by Methode under 3.1.

5.3 This agreement terminates after five (5) years.

## **6.0 Confidential Information**

It is agreed that both parties will mark as Proprietary all such Information which they wish to be kept confidential. Linear and Methode both agree to receive such information and hold it in confidence, limiting access to such Proprietary Information to its employees or agents who have a need to know such Proprietary Information in order to accomplish the goal of this Agreement. The obligations of this paragraph shall terminate four (4) years from the date of this Agreement, survive any termination hereof if before four (4) years and impose no obligation upon the Receiving Party with respect to any portion of the received information; (a) which was known to recipient prior to its first receipt from the other party; (b) which is now or shall hereafter through no act or failure to act upon the part of the recipient become generally known; (c) which is furnished to others by disclosing party without restriction on disclosure; (d) which is hereafter furnished to the recipient by a third party and without restriction on disclosure; or (e) which is independently developed by the Recipient. Each party agrees that upon request by the other party or upon termination of this Agreement, the receiving party will return all proprietary information to the disclosing party.

## **7.0 Modification**

This Agreement may not be modified, altered, changed or amended in any respect unless in writing and signed by both parties.

## **8.0 Notice**

Any notice to be given hereunder shall be in writing and addressed as follows, or to such other address as the recipient may specify:

**Linear Dimensions**  
1648A N. Mohawk Ave.  
Chicago, Illinois  
60614

**Methode Electronics**  
7444 West Wilson Ave.  
Chicago, Illinois  
60656

## **9.0 Disputes**

Disputes which cannot be resolved by the parties shall be put to the American Arbitration Association in the State of Illinois for non-binding ADR. If the ADR process is unsatisfactory, the parties may resolve disputes in court.

## **10. Indemnity**

Methode shall indemnify and ensure that Linear is held harmless against claims by others that the proprietary technical design information provided by Methode does not infringe others' patents.

## **11. Invalidity**

If any provision of this Agreement is declared void or unenforceable, such provisions shall be deemed to be amended so that the same shall be enforceable to the fullest extent permitted by law, or if totally invalid or unenforceable, such provisions shall be deemed to be severed from this Agreement, and the balance of the Agreement will remain in full force and effect.

## **12. Entire Agreement**

This Agreement sets forth the entire Agreement of the parties with respect to the subject matter herein. There are no understandings, agreements or representations, express or implied not specified herein. This Agreement may not be amended except by an agreement in writing executed by the parties.

IN WITNESS HEREOF, the parties have caused this Agreement to be executed by their authorized representatives as of the date first above mentioned.

LINEAR DIMENSIONS, INC.

*Ronel W. Giedt*  
(Officer of the Company)

*RONEL W. GIEDT, PRESIDENT*  
(Printed Name/Title)

*5 MAR '98*  
(Date)

METHODE ELECTRONICS, INC.

*James W. McSwiney*  
(Officer of the Company)

*JAMES W. McSWINEY*  
(Printed Name/Title)

*3/5/98*  
(Date)

**Schedule 'A'**

Specifications to be mutually agreed upon.





Schedule 'B'

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DESIGN: OPTICAL TRANSCEIVER A<sup>2</sup>SIC (Analog ASIC) Schedule

**NRE SCHEDULE**

Re-design, Simulations, Layout & Prototype at Orbit (16 weeks)	\$25k*
Mask Generation (2 weeks)	\$20k
Engineer Wafer Run (8 weeks)	
Wafers to be staged for prototypes	\$20k
Delivery and Evaluation of Engineering samples (2 weeks)	\$10k

\*Costs of prototyping E<sup>2</sup> may be up to \$7,500 higher.

TOTAL NRE COST: \$75k.

TOTAL DEVELOPMENT TIME: 28 weeks from receipt of final specifications.

PAYMENT SCHEDULE: \$20k with agreement. Balance to be paid as development proceeds.



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**LinearDimensions**  
SEMICONDUCTOR

**MIKE A. WARD**  
VICE-PRESIDENT

445 E. OHIO ST., SUITE 350  
CHICAGO, ILLINOIS 60611  
PHONE 312.321.1810  
FAX 312.321.1830

2108 N. Kenmore Ave  
#2R

60614



**LinearDimensions**  
SEMICONDUCTOR

**DAVID C. SCHIE**  
VICE-PRESIDENT

(312)321-1810

1648A N. MOHAWK AVE.  
CHICAGO, ILLINOIS 60614  
PHONE 312.255.1810  
FAX 312.255.1817

1648A N. Mohawk Ave

60614



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Case No. 902OE002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of  
Gilliland, et al.

For: AUTOMATIC POWER CONTROL  
AND LASER EFFICIENCY  
NORMALIZING THROUGH  
COMPENSATIONS IN  
MODULATION CURRENT

Serial No.

Filed: Herewith

Group Art Unit:

Date: February 4, 2000  
Chicago, Illinois

Box Patent Application  
Assistant Commissioner for Patents  
Washington, D.C. 20231

LIST OF INVENTORS' NAMES

Sir:

The following is a list of the inventors' names:

Patrick B. Gilliland  
Luis Torres  
Evgueniy Anguelov  
David Schie  
Mike A. Ward

Respectfully submitted,

Express Maill No. EL528125724US

Date of Deposit: February 4, 2000

I hereby certify that this paper or fee is being deposited  
with the United States Postal Service "Express  
Mail Post Office to Addressee" on the date indicated above  
and is addressed to Box Patent Application,  
Asst. Commissioner for Patents, Washington, D.C. 20231.

Sandy Barrio

By:

Steven M. Evans  
Steven M. Evans  
Attorney for Applicants  
Reg. No. 35,503  
Methode Electronics, Inc.  
7444 West Wilson Avenue  
Chicago, Illinois 60656  
Tel No. (708) 867-9600  
Fax: (708) 867-7690

PATENT

Attorney Docket No. 902OE002



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TO ALL WHOM IT MAY CONCERN:

Be it known the we, Patrick Gilliland, Luis Torres, Evgueniy Anguelov, David Schie and Michael Ward, have invented an AUTOMATIC POWER CONTROL AND LASER SLOPE EFFICIENCY NORMALIZING CIRCUIT of which the following is the specification.